

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. APPLN. NO. 09/298,910
ATTORNEY DOCKET NO. Q54131

REMARKS

The Patent Office objects to the Abstract of the Disclosure under MPEP § 608.01(b) as being too lengthy. Applicant herein editorially amends the Abstract of the Disclosure. No new matter has been added. Applicant submits that the Patent Office's objection has been overcome, and requests withdrawal of same.

Claims 10, 12, 14, 16 and 17 have been examined on their merits.

Applicant herein adds new claims 18-24. The new claims 18-24 do not add any new matter. Entry and consideration of the new claims 18-24 is requested.

1. Claims 10, 12, 14, 16 and 17 stand rejected under 35 U.S.C. § 112 (1st para.) as allegedly failing to comply with the written disclosure requirement. Applicant traverses the rejection of claims 10, 12, 14, 16 and 17 for at least the reasons discussed below.

In view of the disclosure at page 7, lines 19-23 of the instant written disclosure, the Patent Office's new matter rejection regarding a "single digit dialing signal" is unsupportable. Moreover, the Examiner has not established a reasonable basis to question the enablement provided in specification of the present application. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993); MPEP § 2164.04. The Examiner is obligated to provide reasonable explanation as to why the scope of protection provided by the claims is not adequately enabled by the disclosure, but no such explanation has been provided. However, in order to advance prosecution of the instant application, Applicant has amended claims 10, 12, 14, 16 and 17 to recite that a dialing signal is sent each time a key on the dial pad is pushed.

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Applicant herein amends claims 10 and 16 to recite that a dialing signal is generated each time when a key of a dial pad is pushed. It is fairly obvious from the written disclosure that a single dialing signal is generated in response to each push on the dial pad.¹ Claims 10 and 16 are further amended to recite that the base station determines if a received dialing signal represents the final digit of a dialed telephone number. *See* page 7, lines 23-25 of the instant written disclosure. Applicant submits that the § 112 (1st para.) rejection of claims 10 and 16 has been overcome, and requests withdrawal of same.

Applicant herein amends claims 12 and 14 to recite that a dialing signal is generated each time when a key of a dial pad is pushed. Claims 12 and 14 are further amended to recite that the means for producing dialing signals determines if a received dialing signal represents the final digit of a dialed telephone number. *See* page 4, lines 17-23; page 7, lines 23-25 of the instant written disclosure. Applicant submits that the § 112 (1st para.) rejection of claims 12 and 14 has been overcome, and requests withdrawal of same.

Applicant herein amends claim 17 to recite that a dialing signal is generated each time when a key of a dial pad is pushed. Claim 17 is further amended to recite that the means for producing dialing signals determines if a received dialing signal represents the final digit of a dialed telephone number. *See* page 4, lines 17-23; page 7, lines 23-25 of the instant written

¹ “The subscriber terminal 4 then sends a dialing signal (PB or PD), produced each time a key of the dial pad on the telephone set 5 is pushed to dial a telephone number, to the base station 3 (or the base station control station 2).” *See* page 7, lines 19-23 of the instant written disclosure.

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disclosure. Applicant submits that the § 112 (1st para.) rejection of claim 17 has been overcome, and requests withdrawal of same.

2. Claims 10, 12, 14, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bilgic *et al.* (U.S. Patent No. 5,884,148) in view of Suonvieri (U.S. Patent No. 6,047,181). Applicant traverses the rejection of claims 12, 14 and 17, and insofar as the rejection might apply to new claims 18-24, at least for the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior

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art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Examiner acknowledges that Bilgic *et al.* do not disclose or suggest a base station comprising means for deciding whether a dialing signal represents a final digit of a dialed telephone number or not. The Examiner suggests that Suonvieri allegedly discloses the subject matter to overcome the acknowledged deficiencies of Bilgic *et al.*

With respect to claims 10, 12, 14, 16 and 17, the combination of Bilgic *et al.* and Suonvieri fail to teach or suggest transmitting single digit dialing signals to a telephone exchange or a base station control station as each dialing signal is generated. Bilgic *et al.* disclose, *inter alia*, that dialing signals, such as DTMF tone signals or pulse signals, are generated by the telephone or CPE. *See, e.g.*, col. 9, lines 1-4 of Bilgic *et al.* The base station stores the dialed

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signals (the numbers dialed) and formats them appropriately according to the numbering plan of the locality in which the base station is situated. *See* col. 9, lines 42-46; col. 11, lines 38-48; Fig. 3, steps 311-320 of Bilgic *et al.* Once all of the numbers have been dialed, the base station inserts the entire string of numbers at a call setup message that transmits all of the numbers at once to the base station controller. *See* col. 12, lines 49-55; Fig. 4A, service request message 420 of Bilgic *et al.* In other words, the base station sends all of the dialing signals to the base station controller all together at one time. The combination of Suonvieri with Bilgic *et al.* fails to overcome the fundamental deficiencies of Bilgic *et al.*, in that Suonvieri does not discuss, and does not at all relate to the manner of transmission of dialing signals among different parts of a radio communications system. For instance, the Examiner's citation to Suonvieri (col. 5, lines 19-39) does not relate to deciding whether a dialing signal represents a final digit of a dialed telephone number, as the claims require. Rather, Suonvieri describes how the dynamic changing of timing advance ranges in and among cells in a cellular telephone network can be done by either the base station or the base station controller. *See* col. 5, lines 31-38 of Suonvieri. In sum, Suonvieri is totally unrelated to deciding whether a dialing signal represents a final digit of a dialed telephone number. Moreover, the combination of Bilgic *et al.* and Suonvieri fails to teach or suggest the transmission of each dialing signal to a base station control station or an exchange, as recited in claims 10, 12, 14, 16 and 17. As noted earlier, the Examiner argues that Bilgic *et al.* discloses that single digits are sent. However, it is abundantly clear that the base station inserts the entire string of numbers at a call setup message that transmits all of the numbers at once to the base station controller. *See* col. 12, lines 49-55; Fig. 4A, service request message 420 of

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Bilgic *et al.* Moreover, the invention recited in claims 10, 12, 14, 16 and 17 transmits the dialing signals to the base station control station/exchange as they are dialed; that fundamental deficiency of the combination of Bilgic *et al.* and Suonvieri is never addressed in the Examiner's rejection analysis for claims 10, 12, 14, 16 and 17.² Thus, Applicant submits that the Examiner cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Bilgic *et al.* nor Suonvieri disclose transmitting dialing signals to a telephone exchange or a base station control station as each dialing signal is generated, Applicant submits that one of skill in the art would not be motivated to combine the references. *In re Dembicza*k and *In re Zurko* require the Examiner to provide particularized facts on the record as to why one of skill would be motivated to combine the references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner must make specific factual findings with respect to the motivation to

² The drawings clearly support Applicant's assertion that dialing signals are transmitted to the base station control station/exchange as they are dialed. *See, e.g.*, Figure 3 and 4 of the instant application. Applicant reminds the Examiner that possession of an invention can be shown by disclosure of drawings that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. *See, e.g.*, *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991) ("drawings alone may provide a 'written description' of an invention as required by Sec. 112"); *In re Wolfensperger*, 302 F.2d 950 (CCPA 1962) (the drawings of applicant's specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, 384 F.2d 391, 398 (Ct. Cl. 1967) ("In those instances where a visual representation can ... (footnote continued)

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combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). One of ordinary skill in the art would not have been motivated to combine these references in the manner suggested by the Examiner, because they teach unrelated technologies. For example, Bilgic *et al.* is directed to connecting a standard non-wireless device with a wireless system, while providing flexibility with respect to the telephone numbering scheme and dialing signal analysis of the systems geographic location. *See* col. 2, lines 29-36 of Bilgic *et al.* In contrast, Suonvieri relates to intracell capacity allocation and intracell handover in conventional cellular telephone systems. *See* col. 1, lines 11-14 of Suonvieri. There is no overlap in the teachings of the inventions of these references, and no suggestion in either reference that would motivate combining one with the other. In particular, the invention of Suonvieri has no need for connecting a standard non-wireless device with a wireless system, because it relates solely to connecting conventional wireless devices together. Thus, Applicant submits that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembicza*k and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Bilgic *et al.* and Suonvieri fails to disclose all of the claimed elements as arranged in claims 10, 12, 14, 16 and 17. Therefore, the combination of Bilgic *et al.* and Suonvieri clearly cannot render the present invention obvious as recited in claims 10, 12, 14, 16 and 17. Thus, Applicant submits

flesh out words, drawings may be used in the same manner and with the same limitations as the specification.”).

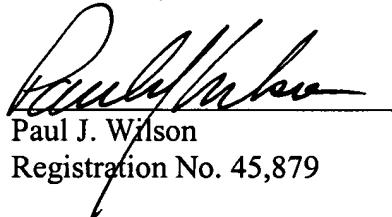
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that claims 10, 12, 14, 16 and 17 are allowable, and requests that the Examiner withdraw the § 103(a) rejection of claims 10, 12, 14, 16 and 17.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: June 24, 2004